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20 November 2003

OFFICIAL

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To: MELODY M. BURCH, Patent Examiner, Art Unit 3683, U.S. Patent
and Trademark Office

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Remarks:

In re Patent Application of:
JEN-HOUNE HANNSEN SU and
ROBERT JOSEPH GALLANT

Attorney Docket No.: 82,593
Serial No.: 09/972,292
Filing Date: 10/04/01

Title: CONSTANT NATURAL FREQUENCY
PASSIVE-ACTIVE MOUNT

Confirmation No.
3357

Art Unit: 3683

Examiner:
Melody M. Burch

Faxed herewith please find the following papers, which are being formally filed in the U.S. Patent and Trademark Office in response to the Office action mail-dated 25 August 2003:

- (1) Request to Vacate Final Rejection.....6 pages
- (2) Amendment under 37 CFR 1.116.....22 pages

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PATENTS
RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
JEN-HOUNE HANNSEN SU and
ROBERT JOSEPH GALLANTAttorney Docket No.: 82,593
Serial No.: 09/972,292
Filing Date: 10/04/01Title: CONSTANT NATURAL FREQUENCY
PASSIVE-ACTIVE MOUNT:
:
: Confirmation No.
: 3357
:
: Art Unit: 3683
:
: Examiner:
: Melody M. Burch**REQUEST TO VACATE FINAL REJECTION**Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This paper and the accompanying Amendment under 37 CFR 1.116 are responsive to the second Office action, mail-dated 08/25/03, and are pursuant to 37 CFR 1.116 and 37 CFR 1.121.

Applicant respectfully requests withdrawal of the finality of the Office action mail-dated 08/25/03, deemed "final" by the Office.

Certificate of Transmission under 37 CFR 1.8

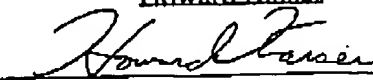
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. (703) 872-9306)

on Thursday, 20 November 2003.

Typed or printed name of person signing this certificate

Howard Kaiser

Signature



Serial No. 09/972,292

Request to Vacate Final Rejection

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In requesting withdrawal of finality, Applicant believes that, by the 08/25/03 Office action, "the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." MPEP 706.07(a), entitled "Final Rejection, When Proper on Second Office Action"

It is respectfully pointed out that the IDS provision of MPEP 706.07(a) is inapplicable to the present application, as Applicant neither filed nor attempted to file an information disclosure statement during the period set forth in 37 CFR 1.97(c). That is, Applicant did not file any IDS between the 02/18/03 mailing of the first Office action and the 08/25/03 mailing of the second Office action. Therefore, the discussion hereinbelow is confined to the remaining question, viz., whether the introduction of a new ground of rejection is necessitated by Applicant's amendment of the claims.

Applicant respectfully contends that either of the following rejections precludes finality of the Office action mail-dated 08/25/03:

- (a) The rejection of claim 17 under 35 U.S.C. 103 as being unpatentable over Su U.S. Patent 5,899,443.
- (b) The rejection of claims 1-7 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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35 U.S.C. 103(a)

The rejection of claim 17 under 35 U.S.C. 103(a) is not necessitated by Applicant's amendment of the claims per Applicant's Amendment filed 05/17/03.

By way of explanation, the Office action mail-dated 02/18/03 rendered a rejection of claims 1-7, 14-21 and 24-26 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The 02/18/03 Office action also rendered a rejection of claims 1-6, 8-12, 14 and 20 under 35 U.S.C. 102(b) as being anticipated by Su U.S. Patent 5,899,443.

It is respectfully emphasized that the 02/18/03 Office action did not reject original claim 17 on any art ground, but only rejected original claim 17 on an indefiniteness ground. Specifically, the only basis for the 02/18/03 Office action's rejection of original claim 17 was the indefinite terminology "PID-type" presented in original claim 14. As quoted hereinbelow (from the "Remarks" section of Applicant's 05/17/03 response), Applicant's 05/17/03 response rewrites claim 17 in independent form so as to avoid/overcome the indefiniteness rejection by reciting "PID controller" vice "PID-type controller":

Claim 17, originally dependent from independent claim 14, is

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amended herein to be an independent claim 17 that includes all of the limitations of the base claim and intervening claims. Thus, claim 17 includes all of the limitations of original claim 14 and original claim 17. The indefiniteness in claim 14, asserted by the Office, has been corrected by reciting "PID-type" in lieu of "PID" (which the Examiner considers to be less definite) in both occurrences. Amended claim 17 is respectfully urged to be allowable, since amended claim 17 is free of indefiniteness and is not otherwise rejected by the Office.

The 08/25/03 Office action renders a rejection of claims 1-27 under 35 U.S.C. 103(a) as being unpatentable over Su U.S. Patent 5,899,443. Claim 17 is thus rejected under 35 U.S.C. 103(a), this being a new ground of rejection. This rejection of claim 17 under 35 U.S.C. 103(a) represents a new ground of rejection that could not possibly have been necessitated by Applicant's amendment of claim 17, since Applicant's 05/17/03 response leaves claim 17 unchanged in all respects but the use of the "PID controller" terminology instead of the "PID-type controller" terminology. That is, Applicant's 05/17/03 effects only the following: (i) the exact rewriting of claim 17 in independent form; and, (ii) the change of the term "PID controller" to the term "PID-type controller."

35 U.S.C. 112, second paragraph

The rejection of claims 1-7 under 35 U.S.C. 112 is not necessitated by Applicant's amendment of the claims per Applicant's Amendment filed 05/17/03.

By way of explanation, as noted hereinabove, the Office

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action mail-dated 02/18/03 rendered a rejection of claims 1-7, 14-21 and 24-26 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The asserted bases for the 02/18/03 Office action's indefiniteness rejection largely differ from the asserted bases for the 08/25/03 Office action's indefiniteness rejection of claims 1-7.

Nevertheless, one of the asserted bases for the 02/18/03 Office action's indefiniteness rejection is not necessitated by Applicant's 05/17/03 response to the 02/18/03 Office action. By the 08/25/03 Office action, the Office disapproves of the phraseology "a first said single frequency bandwidth," especially so with respect to the portion "a first said." The 08/25/03 Office action states, "It is unclear whether Applicant intends to claim a first of several single frequency bandwidths or if the single frequency bandwidth (sic)." To the extent that Applicant understands this ground for rejection, the Office's reasoning involving the amendatory phrase "a first said single frequency bandwidth" would seem to equally apply to the original phrase "the same first frequency bandwidth." It is therefore respectfully contended that Applicant's amendment of claim 1 has not necessitated the indefiniteness rejection on this ground.

Accordingly, Applicant respectfully requests that the Office withdraw the finality of the Office action mail-dated 08/25/03.

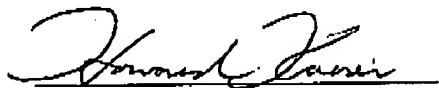
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Please note that Applicant's Amendment under 37 CFR 1.116, mentioned hereinabove, is being filed concurrently herewith. Applicant respectfully requests that the Office enter the amendments proposed by Applicant's Amendment under 37 CFR 1.116, and reconsider the application as amended thereby. "When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered." MPEP 706.07(e).

Respectfully submitted,


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11/20/03
date

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